REMARKS

In response to the Decision on Request for Rehearing mailed January 23, 2009, Appellant hereby elects to reopen prosecution based on the recognition by the Board of the new rejection applied against claims 17-19.

Appellant maintains that, in sustaining the rejection of all appealed claims, the Board incorrectly construed the "soft-sided outer shell" as being capable of both an organized and an unorganized reduction in volume. Specifically, Appellant maintains that this term should be properly limited to only those outer shells capable of an unorganized reduction in volume (i.e., not a folding or collapsing mechanism along predetermined seems or joints). Notwithstanding, Appellant hereby amends independent claim 6 (the sole independent claim on appeal) to explicitly require that feature. Applicant respectfully submits that this amendment traverses the Board's reasons for affirming the previous rejections and clearly distinguishes the claimed invention from the outer shells of the cited prior art.

Additionally, claims 26-30 are newly added. Independent claim 26 represents claim 17 (newly rejected by the Board), rewritten in independent form and further requiring that the inner frame be collapsible along a vertical crease in the each of the side walls. This mechanism for collapsing the inner frame is not taught or suggested by any of the cited prior art.

Status of Claims

Claim 6 is amended, and claims 26-30 are newly added. Following these amendments, claims 6-10, 12-19, and 25-30 are pending and under examination and claims 1-5 and 20-24 are withdrawn.

Support for the amendment to claim 6 is found in the Specification at [0011]. Claim 26 represents claim 17 rewritten in independent form and further requiring that the opposing side walls each comprise a vertical crease to allow a reduction in a distance between said longitudinal

walls. Support for new claim 27 is found in claim 18 and in Figure 3 (element 134). Support for new claims 28-30 is found in claims 19, 9, and 25, respectively.

Rejection of Claims 6-10, 12-16, and 25 Based on the Combination of Redzisz and Zeddies

Claims 6-10, 12-16, and 25 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Redzisz et al. (U.S. Patent Publication 2003/0136702; hereinafter "Redzisz") in view of Zeddies (U.S. Patent 6,336,342), alone or in further combination with additional secondary references.

In affirming these rejections, the Board has adopted the following conclusions of law:

1. Appellant's claim term 'soft-sided' does not mandate a container system that collapses in a manner that produces an unorganized reduction in volume. Decision on Request for Rehearing at page 4.

2. The preponderance of the evidence supports the conclusion that Redzisz teaches a container with a soft-sided outer shell. Decision on Request for Rehearing at page 7.

3. The preponderance of the evidence fails to establish that Zeddies requires a substantially rigid wall. Decision on Request for Rehearing at page 9.

4. It would have been prima facie obvious to a person of ordinary skill in the art at the time the invention was made to use Zeddies' frame in Redzisz's container. Decision on Request for Rehearing at page 12.

Appellant addresses each of these conclusions of law independently below and respectfully submits that, in view of the current amendment to independent claim 6 (the sole independent claim against which these rejections are based), the rejections based on the combination of Redzisz and Zeddies are traversed.

Conclusion of Law #1:

In affirming these rejections, the Board has held that the term 'soft-sided' does not mandate that the claimed container system collapse in a manner that produces an unorganized reduction in volume. Decision on Request for Rehearing at page 4. Appellant respectfully disagrees with the Board's conclusion on this issue. However, in order to expedite prosecution, the pending claims are amended, rendering moot this Conclusion of Law upon which the Board relies.

Claim 6, the sole independent claim reviewed by the Board, is amended herein to require that the soft-sided outer shell is at least partially collapsable by an unorganized reduction in volume. This limitation is also found in newly added independent claim 26.

Conclusion of Law #2:

As noted above, in its affirmation of the rejections, the Board refused to interpret the claim term 'soft-sided' as being limited to an outer shell capable of an unorganized reduction in volume. The claims as currently amended now affirmatively require this feature.

Appellant reasserts that neither Redzisz nor Zeddies provides a 'soft-sided' container, as that term is currently used in the pending claims and the Board's reliance on the similarity of construction materials is misplaced. Decision on Request for Rehearing, FF3, at page 4. In each Redzisz example, the container is shown free-standing with no indication that it is collapsible in an unorganized way. For example each of the Redzisz figures depicts a parallelepiped container formed by sharp and well-defined wall panels. Redzisz at Figures 1-9 and [0004]. Nothing in these figures indicates that the walls are capable of an unorganized reduction in volume. Consistent with the notion of having rigid or semi-rigid side walls, each of the Redzisz embodiments are depicted with sharp score lines or stitches to define a folding line. See, for example, Redzisz at Figures 4-11 Decision on Appeal, FF 1, Reply Brief at page 7, Record of Oral Hearing at page 11, lines 5-13 and 21-24. A "soft-sided" container capable of an

unorganized reduction in volume negates the need for the sharp predefined folding lines described by Redzisz.

Furthermore, Redzisz' description of the container's function is inconsistent with a soft-sided outer shell. The Redzisz container is designed to "maintain[] its structural integrity and shape when the case is fully opened." Redzisz at [0010]. The ability to maintain structural integrity in the fully opened configuration is inconsistent with a soft-sided container that is capable of a disorganized reduction in volume upon the application of "relatively little force." Thus, the Redzisz' description of the container's function supports that the sides must be rigid or semi-rigid, not soft-sided and capable of an unorganized reduction in volume.

Instead, the Redzisz container therefore is more properly described as "foldable" rather than "collapsible;" as the latter term is used in reference to the claimed invention. For example, in Redzisz Figures 3-8, the opposite end walls 28 are illustrated as having a folding seam at the junction with the bottom wall (as described for the junction between the longitudinal wall and the bottom wall), and a central folding seam (unlabeled) that is substantially continuous with the bottom wall mid seam score line 80. The folding action (i.e., organized reduction in volume) of the Redzisz container is repeatedly illustrated in Figure 3-8. In each figure, the container folds in an organized and structured manner along predetermined seam lines. Nothing in the text of the Redzisz specification is contrary to, or modifies this basic folding structure. In particular, nothing in Redzisz suggests an unorganized reduction in volume.

The Board has pointed to no evidence in Redzisz that the container is capable of an unorganized reduction in volume. Instead, the Board relies merely on a similarity in construction materials to suggest that the Redzisz container possesses similar properties to those of the claimed invention. Decision on Request for Rehearing, FF 3-4, at pages 4-5. The Redzisz construction materials are defined too generically to draw any firm conclusions as to the particular features of the manufactured item. One must look to the particular teachings and examples of Redzisz in order to ascertain the desired implementation. In sum, there is no

example or indication in Redzisz of a container in which the sides themselves are capable of being "bent or folded, either easily or with relatively little force" in a disorganized manner.

Conclusion of Law #3:

Similar to Redzisz, the Zeddies container is not "soft-sided" and is not capable of an unorganized reduction in volume. The Board again relies solely on the construction materials of the Zeddies container (thermal-retentive material and optionally a flowable gel material; . Decision on Request for Rehearing, FF 5, at page 8) and asserts that there is no evidence that these materials do not conform to the rejected claims. However, as above, this generic description of the construction materials does not support any particular final construction or properties. Instead, one must look to the Zeddies specification for guidance on the implementation of the final product. In this case, the Zeddies container has substantially rigid sides and is collapsible along pre-determined bend lines once the inner frame is removed and the side wall fasteners (e.g., see part 34) are undone. See, for example, Zeddies at col. 4, ll. 16-20. Neither the Examiner nor the Board has pointed to anything in Zeddies to indicate that the outer shell is capable of an unorganized reduction in volume.

Conclusion of Law #4:

The Board alleges that it would have been prima facie obvious to a person of ordinary skill in the art to use Zeddies' frame in Redzisz' container. Decision on Request for Rehearing, at page 12. Appellant respectfully disagrees, and particularly insofar as this rejection applies to the currently amended claims.

As an initial matter and as discussed above, the pending claims have been amended to specify that the soft-sided outer shell is capable of an unorganized reduction in volume. Neither the Redzisz nor the Zeddies outer shell is capable of this type of volume reduction. Regardless of whether or not the Redzisz outer shell is characterized as "rigid," "semi-rigid," or "soft-sided" is irrelevant to the instant claims. In every example and disclosure, Redzisz describes a container

which is foldable along pre-determined folding lines (i.e., seams), rendering the container capable only of an organized (not an unorganized) reduction in volume. Likewise, the Zeddies container is characterized by panels held together by Velcro® straps or other similar fasteners. The Zeddies container is designed to be fully expanded (held in place using the inner frame) or fully collapsed when the corner fasteners are undone; the latter being an organized reduction in volume. Thus, the outer shell of Redzisz and/or Zeddies is substantially different in construction and function from that of the presently claimed invention. For this reason alone, this rejection is traversed and should be withdrawn.

Appellant further traverses this rejection on the ground that there is no motivation to combine the inner frame of Zeddies with the outer shell of Redzisz, as alleged by the Office. The Zeddies outer shell forms a weakly constructed container wherein the side panels are fastened together using Velcro® straps or other similar fasteners. It is clear that the Zeddies outer shell alone has little structural integrity. Thus, in order to serve its function as a transport container for cargo of any significant weight, the Zeddies outer shell requires combination with a rigid inner frame. In contrast, the Redzisz container is designed to "maintain[] its structural integrity and shape when the case is fully opened." Redzisz at [0010]. Thus, contrary to the Board's allegation, one would not be motivated to insert a collapsible frame (such as the frame of Zeddies) into the Redzisz container because one is not needed. The Board's rationale rests merely on an assertion of motivation solely because the combination could be made, not because the combination should be made or that any advantage or improvement would be gained by the combination. The fact that the Redzisz container is not collapsible in the same manner as Zeddies' container renders the internal frame unnecessary.

Taken together, the combination of Redzisz and Zeddies only provides alternatives for containers that fold or collapse along predetermined lines (i.e., an organized reduction in volume). Nothing in either reference teaches or suggests a soft-sided container (as that term applies to the instant claims) that is capable of an unorganized reduction in volume. Thus, this rejection is traversed by the current claim amendments.

Rejection of Claims 17-19 Based on the Combination of Redzisz and Zeddies in further view of Travis

The Board newly rejects claims 17-19 over Redzisz and Zeddies in further view of Travis (U.S. Patent 4,485,159). Specifically, the Board alleges that the claimed container including the inner frame is obvious over the combination of Redzisz and Zeddies and that the walls of the Zeddies frame are pivotally mounted on the bottom frame panel. The Board further alleges that there is no evidence that the pivotable mounts of Zeddies' frame could not be replaced with the wall linkages taught by Travis to accomplish the same purpose of allowing the frame to collapse in a manner that reduces the distance between the frame's longitudinal walls. Appellant respectfully traverses this rejection.

As an initial matter, Appellant notes that claim 6 (from which claims 17-19 depend) has been amended to require that the outer shell be at least partially collapsible by an unorganized reduction in volume. For the reasons discussed above, the combination of Redzisz and Zeddies does not teach or suggest such an outer shell. Travis is cited specifically for features related to the inner frame, not the outer shell. Thus, Travis cannot remedy the deficiencies of the Redzisz/Zeddies combination. This rejection of claims 17-19 is therefore traversed for this reason alone.

This rejection is inapplicable to new claims 26-30. Each of these newly added claims requires an inner frame in which each of the side walls comprises a vertical crease to allow a reduction in a distance between said longitudinal walls. An example of a suitable vertical crease in the side walls is illustrated in Figure 5 (see, for example, element 134). In essence, this permits the inner frame to be folded along the vertical creases thereby collapsing the frame and reducing the distance between the longitudinal walls.

The vertical crease folding system is not taught or suggested by either Zeddies or Travis, the only two prior art references relevant to the inner frame. As noted by the Board, the Zeddies frame reduces the distance between the longitudinal walls using pivotable mounts on the bottom

frame panel. The Travis inner frame pivots about hinges located at the corner junctions made between the longitudinal walls and the side walls. Neither reference teaches or suggests an inner frame that is collapsible along a vertical crease in the side walls of the frame. Accordingly, this rejection is inapplicable to new claims 26-30.

CONCLUSION

Applicant respectfully submits that the pending claims are in condition for allowance. An early notice to that effect is earnestly solicited. Should any matters remain outstanding, the Examiner is encouraged to contact the undersigned at the telephone number listed below so that they may be resolved without the need for a written action.

The Commissioner is hereby authorized to charge any fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 03/20/2009

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